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EXAMINER	
WEISBERGER, RICHARD C	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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TECHNOLOGY CENTER 3600

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In re Application of
Michael Waller et al.
Application No. 09/780,696
Filed: February 9, 2001
Attorney Docket No.: 8771.00
For: Self Service Terminal

DECISION ON PETITION
UNDER 37 CFR §1.181

This is a decision on applicant's petition under 37 CFR 1.181 filed January 15, 2008 requesting that the amendment filed with the Appeal Brief of August 23, 2007 be entered.

The petition is **GRANTED-IN-PART** to the extent indicated below.

In the petition filed under 37 CFR 1.181 on January 15, 2008 Applicant requests 1) the Notice of Non-Compliant Amendment be withdrawn, and 2) the Amendment mailed August 20, 2007, together with the Appeal Brief mailed on that date be entered into the file, and submitted to the Board of Appeals.

Applicant argues that the refusal to enter the amendment is unfair because: (1) the Amendment re-wrote the claims from dependent form into independent form, to overcome the 112 objections and (2) MPEP 1206 and 37 CFR 41.33 specifically allow amendments to be submitted after final.

The record reflects that;

On March 22, 2007 a Final Office action was mailed with the following rejections:

- Claims 30, 31, 33-35 and 36-56 under 35 U.S.C. 112 2nd paragraph;
- Claims 30, 31, 33-50, 52 and 53 under 35 U.S.C. 102(e)

Additionally, the Examiner noted in the Final Office Action that claims 51, 54, 55 and 56 would be allowable if they were amended to overcome the 112 2nd rejections.

On June 19, 2007 Applicant filed a Notice of Appeal.

On August 23, 2007 Applicant filed; (1) an Appeal Brief appealing all rejections and including a Claims Appendix with a copy of the claims as presented prior to the Final Rejection, and (2) an After Final Amendment and Remarks, amending claims 51 and 54 (claims 55 and 56 ultimately depend from claim 54).

On December 11, 2007 a Notice of Non-Compliant Amendment was mailed stating, "The Applicant has filed both an appeal brief and an amendment after final. The response to the final may be either an amendment after final or an appeal brief."

On January 15, 2008 Applicant submitted a Supplemental Appeal Brief.

37 CFR 41.33(b) states: Amendments filed on or after the date of filing a brief pursuant to 41.37 may be admitted: (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) To rewrite dependent claims into independent form.

MPEP 1206 states:

Rewriting dependent claims into independent form as permitted under 37 CFR 41.33(a)(2) includes the following situations: (A) rewriting a dependent claim in independent form by adding thereto the limitations of the parent claim(s); and (B) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim.

If the examiner denies entry of an amendment filed on or after the date of filing a brief, the examiner should use form PTOL-304, "Advisory Action After the Filing of an Appeal Brief," to notify the applicant of the non-entry and the reason for non-entry.

Examiners must respond to all amendments filed after appeal has been taken and prior to termination of the appeal. If the examiner indicates (in the advisory action) that an amendment would be entered, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be impacted by the entry of the amendment except where an amendment merely cancels claims. If the examiner determines that an amendment clearly places the application in condition for allowance, the examiner may enter the amendment and allow the application. Except for amendments that meet the conditions set forth above, all other amendments submitted after the date of filing a notice of appeal will not be entered except as permitted by 37 CFR 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

With respect to Applicants request to have the Notice of Non-Compliant Amendment mailed withdrawn, MPEP 1206 clearly indicates that the appropriate response to an amendment filed after final and after the filing of an appeal brief is PTOL-304, "Advisory Action After the Filing of an Appeal Brief." As such the Notice of Non-Compliant Amendment mailed December 11, 2007 is hereby **WITHDRAWN** and the case is returned to the examiner to consider whether to enter the amendment.

With respect to Applicant's request that the Amendment mailed August 20, 2007 together with the Appeal Brief mailed on that date be entered, a review of the record shows that the amendment was never considered by the Examiner and therefore never explicitly "not entered." As such, the case is returned to the Examiner for consideration.

The petition is **GRANTED-IN-PART** to the extent indicated above.

Any questions regarding this decision should be directed to Jay Kramer at (571) 272-6783.



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Jk/snm:4/25/08

